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| 09/248,515 | 02/08/1999 | HOWARD B. SOSIN | 2001611-0004 | 8867 |

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| EXAMINER |
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BLAU, STEPHEN LUTHER

| ART UNIT | PAPER NUMBER |
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3711

DATE MAILED: 11/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/248,515

Applicant(s)

SOSIN, HOWARD B.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-54 and 59-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-54 and 59-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 51, 53-54, and 59-69 stand rejected under 35 U.S.C. 102(b) as being anticipated by Thompson.

Thompson discloses an iron-type golf club having a head with a sole, a single design loft (Fig. 2), a single straight hosel for connection to a shaft (Figs. 1-2), a connection arranged so that the shaft forms a non-zero lean angle with the vertical when the head rests on its sole in the form of when the head is rested along the bottom on the sole (Fig. 2), the non-zero lean angle being greater than 3 degrees in the form about 6 degrees (Fig. 2), an iron being a wedge (Col. 2, Lns. 8-16), and when a head rests on its sole an impact face is positioned at its designed loft (Fig. 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 50 and 52 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Scheie.

Thompson lacks a head and hosel being forged or cast. Scheie discloses a head and hosel being forged or cast (Col. 4, Lns. 1-2). In view of the patent of Scheie it would have been obvious to modify the club of Thompson to have the head and hosel being forged or cast in order to utilize a known manufacturing process in the market place.

5. Claims 50-54, 59-60, and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn view of Hirose and Scheie.

Ahn discloses a single design loft, a single straight hosel, a non-zero lean angle, and a lean angle being greater than 3 and less than 10 (Fig. 5).

Ahn lacks a single straight shaft and head and hosel being formed by forging or casting. Hirose discloses an iron club having a single straight shaft (Figs. 13-14, Col. 1, Lns. 10-25). In view of the patent of Hirose it would have been obvious to modify the club of Ahn to have a single straight shaft in order to increase the velocity of the head at impact. Scheie discloses a head and hosel being forged or cast (Col. 4, Lns. 1-2). In view of the patent of Scheie it would have been obvious to modify the club of Ahn to

have the head and hosel being forged or cast in order to utilize a known manufacturing process in the market place.

6. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahn view of Hirose and Scheie as applied to claims 50-54, 59-60, and 67-68 above, and further in view of Adams.

Ahn lacks a wedge type head. Adams discloses a head having a wedge type loft with a lean angle (Col. 2, Lns. 16-27, Figs. 3-5). In view of the patent of Adams it would have been obvious to modify the head of Ahn to include a wedge type head in order to utilize the advantages of Ahn for a wedge type head.

7. Claim 61-63, 66-67, and 69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Hirose.

Adams discloses an iron-type golf club having a head with a sole (Fig. 2), a single straight hosel for connection to a shaft (Figs. 1-2), a connection arranged so that the hosel forms a non-zero lean angle with the vertical when the head rests on its sole in the form of when the head is rested along the bottom on the sole (Figs. 3-5), the non-zero lean angle being greater than 3 degrees in the form about 8 degrees (Fig. 5), an iron being a wedge (Col. 2, Lns. 16-27), and when a head rests on its sole an impact face is positioned at its designed loft (Figs. 3-5).

Adams lacks a single straight shaft. Hirose discloses an iron club having a single straight shaft (Figs. 13-14, Col. 1, Lns. 10-25). In view of the patent of Hirose it would

have been obvious to modify the club of Adams to have a single straight shaft in order to increase the velocity of the head at impact.

Response to Arguments

8. The argument that Thompson is improper due to Thompson not having a specific description of figure 2 relating to the shaft/head connection and as such those of ordinary skill would understand the club is a standard wedge and thus would not have a lean angle is disagreed with. The more the examiner searches the more woods/irons are found with lean angles. See the conclusion below as well as previous cited art. Lean angle is known in the art and one skilled in the art would know looking at figure 2 that both a lean angle as shown or modifying the lean angle and making it zero are known teachings in the art. The argument that lean angle is a radical departure from the standard is disagreed with. The numerous references cited so far in this case show that the design of a lean angle is known in the art. The argument that figures 2 of Thompson is not drawn to scale or with angular precision and as such it reasonably discloses and suggest to one of ordinary skill in the art of a zero lean angle is disagreed with. Numerous references disclosed have shows significant lean angles as those cited in the conclusion below which can only imply there is a lean angle which is not zero. The lean angle in figure 2 is large enough that combined what is known in the art would lead one of ordinary skill in the art to conclude a positive lean angle as well as modifying

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the iron for a zero lean angle. The arguments with respect to Ahn are disagreed with the same response as stated above for the drawings of Thompson.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Antonious (4,915,386, fig. 3), Antonious (4,900,028, figs. 3,14A), Antonious (4,921,252, figs. 3,14A), Antonious (5,011,151, fig. 11), Antonious (5,603,668, fig. 3), and Blough (5,921,869, Fig. 3) disclose irons with single straight hosels and single design lofts. D'Amico discloses an iron club being used with a lean angle (Fig. 1B).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

Slb 5 November 2003


STEPHEN BLAU
PRIMARY EXAMINER